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10/726,284	12/02/2003	Robin Pou	14706-002001	5291
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FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			WINTER, JOHN M	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/726,284	Applicant(s) POU ET AL.
	Examiner JOHN M. WINTER	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 10 January 2008.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-19,49-54,60-62,74-84,100-103 and 108-112 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-19,49-54,60-62,74-84,100-103 and 108-112 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 11/8/2007, 10/26/2007

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application

6) Other: _____

DETAILED ACTION

Acknowledgements

The Applicants amendment filed on January 10, 2008 is hereby acknowledged.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19,49-54,60-62,74-84,100-103 and 108-112 are drawn to usage protection with plurality of layers, classified in class 705/54.
- II. Claims 20-28,63-65 and 85-88 are drawn to usage protection , classified in class 705/51.
- III. Claims 29-39, 89-94 are drawn to usage protection with credit allocation , classified in class 705/51.
- IV. Claims 40-48,95-00 and 113-118 are drawn to usage protection with a digital key, classified in class 705/51.
- V. Claims 55-59 and 104-107 are drawn to usage protection with a second user device, classified in class 705/51.
- VI. Claims 66-73 are drawn to usage protection with payment processing, classified in class 705/51.

The inventions are distinct, each from the other because of the following reasons:

Inventions I - VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require

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the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination has separate utility such as: A digital wrapper (Group I), allowing access with a recognition algorithm (Group II), credit allocation (Group III), a digital key (Group IV), a second user device (Group V) and processing payment information (Group VI). No group is generic.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Examiner notes that it would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via paper filed on January 10,2008 a provisional election was made without traverse to prosecute the of Invention I, claims 1-19 ,49-54,60-62,74-84,100-103 and 108-112. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20-28, 63-65 and 85-88 29-39, 89-94 40-48,95-00 and 113-118 55-59 and 104-107 66-73 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1-19 ,49-54,60-62,74-84,100-103 and 108-112 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 ,49-54,60-62,74-84,100-103 and 108-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boebert et al (U.S. Patent 6,044,469) in view of Downs et al.

As per claim 1,

Boebert ('946)discloses a method for managing digital rights, the method comprising:
detecting a data file on a user device, wherein the data file includes a digital wrapper preventing access to the data file without a valid authorization; disabling the digital wrapper if an authorization to access the data file is found during the search. (Discussion of "keying of devices – at Column 12,line 17 – column 13, line 19)

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

Boebert ('946)does not explicitly disclose searching for information relating to an authorization to access the data file using data stored in a non-volatile storage area of the user

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device; Downs et al ('618) discloses searching for information relating to an authorization to access the data file using data stored in a non-volatile storage area of the user device; (Column 21, line 64- column 22, line 8) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Boebert ('946) system with the Downs et al ('618) system in order to hide the access key from casual observation.

Claims 49, 60, 74, 100, 108 are not patentably distinct from claim 1 and are rejected for at least the same reasons

As per claim 2,

Boebert ('946) discloses the method of claim 1
wherein the data file comprises a media file.(Abstract)

As per claim 3,

Boebert ('946) discloses the method of claim 1
Boebert ('946) does not explicitly disclose wherein the search for information relating to an authorization to access the data file is conducted in a license database on the user device.
Downs et al ('618) discloses wherein the search for information relating to an authorization to access the data file is conducted in a license database on the user device.; (Column 21, line 64- column 22, line 8) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Boebert ('946) system with the Downs et al ('618) system in order to hide the access key from casual observation.

As per claims 4-6,

Boebert ('946) discloses the method of claim 3

Official Notice is taken that "wherein the license database is located in the non-volatile storage area of the user device; wherein the non-volatile storage area of the user device comprises a basic input/output system (BIOS); wherein the data stored in the non-volatile storage area of the user device includes a location of the license database" is common and well known in prior art in reference to licensing protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a secure memory area such as a BIOS to store a table of licenses in order to create a robust system for controlling access to content or services.

As per claim 7,

Boebert ('946) discloses the method of claim 3

wherein the data stored in the non-volatile storage area of the user device includes an access key for the license database, with the access key being necessary to access the license database. (Discussion of "keying of devices – at Column 12,line 17 – column 13, line 19)

As per claim 8,

Boebert ('946) discloses the method of claim 3

wherein the license database includes an access key for the data file, with the access key being necessary to disable the wrapper. (Discussion of "keying of devices – at Column 12,line 17 – column 13, line 19)

As per claim 9,

Boebert ('946) discloses the method of claim 1

wherein the search for information relating to an authorization to access the data file is conducted in a license database associated with a remote server. (Discussion of "keying of devices – at Column 12,line 17 – column 13, line 19)

As per claim 10,

Boebert ('946) discloses the method of claim 9

wherein the search for information relating to an authorization to access the data file is conducted in the license database associated with the remote server in response to a determination that a local database on the user device does not include information relating to an authorization to access the data file. (Discussion of "keying of devices – at Column 12,line 17 – column 13, line 19)

As per claim 11,

Boebert ('946) discloses the method of claim 9

further comprising sending identification data for the user device to the central server, wherein the identification data is adapted to allow the central server to validate the user device.

(Discussion of “keying of devices – at Column 12,line 17 – column 13, line 19)

As per claim 12,

Boebert ('946) discloses the method of claim 11

wherein the identification data includes a digital key associated with at least one of: the user device; and-or a user associated with the user device. (Discussion of “keying of devices – at Column 12,line 17 – column 13, line 19)

As per claim 13,

Boebert ('946) discloses the method of claim 1

Official Notice is taken that “offering for purchase an authorization to access the data file; receiving an acceptance of the offer to purchase; and disabling the digital wrapper in response to the acceptance of the offer” is common and well known in prior art in reference to licensing protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to sell authorization to use content in order to recoup the expense of producing the content.

As per claim 14

Boebert ('946) discloses the method of claim 13 further comprising:
sending the acceptance of the offer to a central server; receiving a message from the central server in response to the acceptance of the offer, wherein data contained in the message is used to disable the digital wrapper. (Discussion of “keying of devices – at Column 12,line 17 –

column 13, line 19)

As per claim 15

Boebert ('946) discloses the method of claim 14

further comprising sending identification data for the user device to the central server, wherein the identification data is adapted to allow the central server to validate the user device. (Figure 15 –element 24 “security server” is equivalent to central server)

As per claim 16

Boebert ('946) discloses the method of claim 15

wherein the identification data includes a digital key associated with at least one of the user device and for a user associated with the user device. (Column 10, line 30 – the PIN number of the personal keying device)

As per claim 17,

Boebert ('946) discloses the method of claim 13

further comprising storing information relating to an authorization to access the data file on the user device. (Column 9, line 34 – usage of he personal keying device)

As per claim 18,

Boebert ('946) discloses the method of claim 1

further comprising denying access to the data file if an authorization to access the data file is not found during the search and if an offer to purchase an authorization to access the data file is not accepted. (Figure 33)

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

As per claim 19,

Boebert ('946) discloses the method of claim 1

wherein searching for information relating to an authorization to access the data file comprises determining whether the user device includes software for disabling the digital wrapper, with the determination being made using executable instructions stored in the digital wrapper. (Figure 33)

Claims 50-54, 61-62, 75-84, 101-103 and 109-112 disclose the same invention as claims 1-19, because these claims are not patentably distinct from claims 1-19 they are rejected for at least the same reasons.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Winter

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/Jalatee Worjloh/

Primary Examiner, Art Unit 3621